IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Johannes Ruetschi	)	
	)	
Serial No.: 10/625,960	)	Group Art Unit: 2626
	)	
Filed: July 24, 2003	)	Examiner: Justin W. RIDER
	)	
Title: ANNOTATIONS ADDITION TO DOCUMENTS RENDERED VIA TEXT-TO-SPEECH CONVERSION OVER A VOICE CONNECTION	)))))	

Mail Stop **APPEAL BRIEF – PATENTS**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 CFR §41.37(a)

Appellants have filed a Notice of Appeal, February 17, 2009, appealing a final Office action, dated September 15, 2008. A single copy of this brief is provided pursuant to 37 C.F.R. §41.37(a). An authorization to charge the appropriate fee is included herewith. The Commissioner is further authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 50-3818.

I.   Real Party in Interest:

Siemens Communications, Inc. is the real party in interest in the above referenced patent application.

II.   Related Appeals and Interferences:

The appellant is aware of no other appeals or interferences that will directly affect or have a bearing on this appeal.

III.   Status of The Claims:

Claims 1 – 42 are finally rejected and are under appeal herein.

All remaining claims are appended in a "Claims Appendix" attached hereto.

IV.   Status of Amendments:

An amendment amending claims 15 and 35 and filed April 16, 2009, has not yet been entered; all prior amendments are reflected in the appended claims.

V.   Summary of The Claimed Subject Matter:

Independent Claim 1

The invention, as recited by claim 1, is a method for inserting 260, 270 a caller's speech annotations 230 into an original message 210, 270. *See, e.g.*, page 3, lines 25 – 29 of the application with reference to Figure 2, a copy of which is included as Exhibit A in the Evidence Appendix of this Appeal Brief. First, a speech rendering 210 is provided of an original message 200. *See, e.g.*, page 5, lines 3 – 8; *and see*, Figure 2. The spoken message is annotated, e.g., using voice commands/navigation 220 and voice dictation 230 – 250. *See, e.g.*, page 5, lines 9 – 18; *and see*, Figure 2. Then, the speech annotation is inserted 260 into the original message. *See, e.g.*, page 5, lines 30 – 31; *and see*, Figure 2.

Dependent Claim 19

Dependent claim 19 recites that the storing the annotated message includes creating a new copy of the message that includes the original message and inserted annotations. *See, e.g.*, page 6, lines 7 – 10 ("When the caller completes rendering the message, the caller may be asked (preferably using IVR system) to decide if the annotated (edited) message is to be saved as a new message or to replace the original message.").

Dependent Claim 20

Dependent claim 20 recites forwarding the annotated message to another user. *See, e.g.*, page 6, lines 10 – 11.

Dependent Claim 41

Dependent claim 41 recites that the annotated message may be stored over the original. *See, e.g.*, page 6, lines 7 – 10.

Independent Claim 21

The invention, as recited by claim 21, is an apparatus 100 for inserting a caller's speech annotations into an original message 124, 125, 126 and 127. *See, e.g.*, page 4, lines 3 – 7 of the

application with reference to Figure 1, a copy of which is included as Exhibit B in the Evidence Appendix of this Appeal Brief. The apparatus 100 includes means 150 for providing a speech rendering of the original message 124, 125, 126 and 127. *See, e.g.,* page 4, lines 23 – 26 and Figure 1, Exhibit B. The apparatus 100 includes means 110 for annotating the speech message with speech annotations 160, 165. Figure 1. The apparatus 100 also includes means 110 for inserting the speech annotations 160, 165 into the original message. *Id.*

Dependent Claim 39

Dependent claim 39 recites that the storing the annotated message includes creating a new copy of the message that includes the original message and inserted annotations. *See, e.g.,* page 6, lines 7 – 10.

Dependent Claim 40

Dependent claim 40 recites forwarding the annotated message to another user. *See, e.g.,* page 6, lines 10 – 11.

Dependent Claim 42

Dependent claim 42 recites that the annotated message may be stored over the original. *See, e.g.,* page 6, lines 7 – 10.

VI.   Grounds of Rejection to Be Reviewed on Appeal:

Claims 1, 2, 5, 7 – 10, 12 – 18, 21, 22, 25, 27 – 30, and 32 – 38 are finally rejected under 35 U.S.C. §102(e) over published U.S. Patent application No. 2002/0129057 to Spielberg.

Claims 19 and 39 are finally rejected under 35 U.S.C. §103(a) over Spielberg.

Claims 41 and 42 are finally rejected under 35 U.S.C. §103(a) over Spielberg in combination with U.S. Patent No. 5,754,844 to Fuller et al.

Claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 are finally rejected under 35 U.S.C. §103(a) over Spielberg in combination with published European Patent Application No. EP-0-865-189-A2 to Pizano et al.

VII.   Argument:

REJECTION UNDER 35 U.S.C. §102(e)

Spielberg fails to teach and does not suggest "inserting a caller's speech annotations into an original message,[1]" and therefore, Spielberg fails to teach the present invention.

A "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.[2]" Not only must the allegedly anticipating reference describe the invention, but "[t]he identical invention must be shown in as complete detail as is contained in the ... claim.[3]" Furthermore, all of the claims must be read as a whole[4] and as they would be interpreted by those of ordinary skill in the art[5].

Speilberg specifically teaches that "there are **four** basic files associated with the annotation of a document as shown in FIG. 12[6]. These files comprise the original document 1200 (i.e., the document to be annotated). The Annotations Names File 1202, the Annotations Index File 1204, and the Annotations File 1206.[7]" Furthermore, "Document File 1200 comprises the document to be annotated and is **not typically modified during annotation**.[8]" After "the comments are stored in the file structure they may be **reconstructed upon request** by a user. A user may, for example, provide the annotated document to a secretary or some other person in order to finalize the document. In other instances the document is stored for later processing by another person.[9]" There is nothing here or anywhere else in Spielberg, as far as the appellant can

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[1] Claims 1 and 21, lines 1 and 5.
[2] *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).
[3] *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).
[4] See, e.g., MPEP §608.01(n) III.
[5] *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983).
[6] A copy of which is included as Exhibit C in the Evidence Appendix of this Appeal Brief.
[7] Paragraph 0095.
[8] Paragraph 0096 (emphasis added).
[9] Paragraph 0103 (emphasis added).

tell, about inserting the annotations into the document to produce an annotated document. Quite the opposite in fact.

By contrast, as previously noted, claim 1 recites a "method for **inserting** a caller's speech annotations **into** an original message,[10] … ." So the independent claims recite, not just providing annotations, but *inserting* those annotations *into* the original message. This is done by "annotating [a] speech message with at least one speech annotation; and **inserting** [that] speech annotation **into** said original message.[11]"

The Final Office Action (Final), mailed February 17, 2009, turns to the present application to find the description of how each annotation may be added, referring to page 5, lines 27 – 32, to assert that "it would seem from the applicants' own disclosure that a sound file of an annotation is created, stored and then later re-aligned with the original message.[12]"

> In one embodiment of the invention, the user may request to have the annotated information be read back for verification. Further, the caller may accept, reject or edit the annotation. **When the caller completes** the annotation, the text of the annotated speech (or the sound file) **is inserted in the original message** at 260.[13]

It is consistent with the specification that the annotations may be added on the fly, as each is made, or at the end of annotating. Either way, when the annotated file is stored, e.g., as recited in claims 41 and 42, a single file, that includes the original message and the annotations, is stored. Instead, "[w]hen the caller completes rendering the message, the caller may be asked (preferably using IVR system) to decide if the annotated (edited) message is to be saved as a new message or to replace the original message.[14]" That is not the case with Spielberg.

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[10] at line 1 (emphasis added); *see also*, claim 1, line 5 and claim 21, lines 1 and 5.
[11] Claim 1 lines 4 – 5 (emphasis added); *see also*, claim 21, lines 4 – 5.
[12] Final, page 3, #2.
[13] Application, page 5, lines 27 – 32.
[14] *Supra.*

"During examination, the claims must be interpreted as broadly as their terms reasonably allow.[15]" "This means that the words of the claim must be given their plain meaning unless he plain meaning is **inconsistent** with the specification.[16]" Regardless of when the annotations are inserted, whether as each annotations is completed or, after all annotations are completed, that is not what Spielberg teaches.

Instead, Spielberg teaches generating additional annotation files 1202, 1204, 1206 for the original document 1200[17], which is maintained separate and pristine; and so, Spielberg fails to teach a "**inserting** a caller's speech annotations **into** an original message," by "**inserting** said speech annotation into said original message.[18]" Therefore, Spielberg fails to teach the present invention as recited in claims 1 and 21.

Moreover, dependent claims include all of the differences with the references, as the claims from which they depend. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.[19]" The same is holds for anticipation. Therefore, Spielberg fails to teach, and does not suggest, the present invention as recited by claims 2, 5, 7 – 10, 12 – 18, 22, 25, 27 – 30, and 32 – 38, which depend from claims 1 and 21. The Appellants respectfully request reversal of the final rejection of claims 1, 2, 5, 7 – 10, 12 – 18, 21, 22, 25, 27 – 30, and 32 – 38 under 35 U.S.C. §102(e).

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REJECTION UNDER 35 U.S.C. §103(a)

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Claims 19 and 39

As noted hereinabove, regardless of when the annotations are inserted, whether as each annotations is completed or, after all annotations are completed, that is not what Spielberg

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[15] *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004).
[16] *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)
[17] *Supra.*
[18] *Supra* (emphasis added).
[19] *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

teaches or suggests; and therefore, Spielberg does not make the present invention obvious.

"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.[20]" Since Spielberg teaches generating additional annotation files 1202, 1204, 1206 for the original document 1200[21], "storing said annotated message includes creating a new copy of said message, said new copy including said original message and inserted annotations[22]" requires changing a principle of operation of Spielberg. Therefore, modifying Spielberg to combine annotation files 1202, 1204, 1206 for the original document 1200[23] into a single message is not obvious; and Spielberg is "[in]sufficient to render the claims [19 and 39] *prima facie* obvious.[24]" The Appellants respectfully request reversal of the final rejection of claims 19 and 39 under 35 U.S.C. §103(a).

Claims 41 and 42

Likewise, since modifying Spielberg to combine annotation files 1202, 1204, 1206 for the original document 1200[25] into a single message is not obvious; and Spielberg is "[in]sufficient to render the claims [19 and 39] *prima facie* obvious[26];" storing the annotated message over the old message or as a new message is not *prima facie* obvious. Nor does the addition of Fuller et al. (cited[27] to teach querying whether to overwrite or save as new) teach or suggest what is missing from, or overcome this shortfall of, Spielberg. The Appellants respectfully request reversal of the final rejection of claims 41 and 42 under 35 U.S.C. §103(a).

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[20] *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).
[21] *Supra.*
[22] Claims 19 and 39.
[23] *Supra.*
[24] *Supra.*
[25] *Supra.*
[26] *Supra.*
[27] Final, page 10, #8.

Claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40

Neither does either of Pizano et al. (cited[28] to teach an original message containing an attachment) teach or suggest what is missing from, or overcome the above shortfalls of, Spielberg. Therefore, the combination of Pizano et al. with Spielberg fails to result in the present invention as recited in claims 1 and 21, from which claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 depend.

Furthermore, because Spielberg teaches augmenting annotation files 1202, 1204, 1206 for the original document 1200[29], and specifically teaches forwarding all of those separate files for annotation[30] by others or even, just for reviewing others' annotations; "forwarding said annotated message [singular] to another user,[31]" is neither taught nor suggested by Spielberg, Pizano et al. or any other reference of record.

Therefore, the combination of Pizano et al. with Spielberg does not make obvious the present invention as recited in claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40. The Appellants respectfully request reversal of the final rejection of claims 3, 4, 6, 11, 20, 23, 24, 26, 31 and 40 under 35 U.S.C. §103(a).

CONCLUSION

Therefore, the present invention, as recited in claims 1, 2, 5, 7 – 10, 12 – 19, 21, 22, 25, 27 – 30, and 32 – 39 is quite different than Spielberg. Because Spielberg maintains additional annotation files 1202, 1204, 1206 separately for the original document 1200[32], and is not "**inserting** said speech annotation into said original message;[33]" Spielberg fails to teach (and does not suggest) the present invention as recited in independent claims 1, 2, 5, 7 – 10, 12 – 19,

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[28] Final, page 7, #6.
[29] *Supra.*
[30] *Supra.*
[31] claims 20 and 40
[32] *Supra.*
[33] *Supra* (emphasis added).

21, 22, 25, 27 – 30, and 32 – 39 or in any claim depending therefrom. Further, because Spielberg teaches generating additional annotation files 1202, 1204, 1206 for the original document 1200[34], "storing said annotated message includes creating a new copy of said message, said new copy including said original message and inserted annotations[35]" requires changing a principle of operation of Spielberg. Therefore, modifying Spielberg to result in the present invention is not obvious; and Spielberg is not "sufficient to render the claims [3, 4, 6, 11, 29, 20, 23, 24, 26, 31 and 39 – 42] *prima facie* obvious.[36]" Accordingly, the appellants respectfully request that the board reverse of the final rejection of claims 1 – 42 under 35 U.S.C. §§102(e) and 103(a) over Spielberg, alone or further in combination with Fuller or Pizano et al., and pass the application to issue.

Respectfully submitted,

Date: <u>Friday, April 17, 2009</u>

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[34] *Supra.*
[35] Claims 19 and 39.
[36] *Supra.*

CLAIMS APPENDIX

A copy of the claims involved in the appeal is provided below.

1. A method for inserting a caller's speech annotations into an original message, comprising the steps of:

      providing a speech rendering of said original message;

      annotating said speech message with at least one speech annotation; and

      inserting said speech annotation into said original message.

2. The method of claim 1 wherein said original message is a text email message and the step of providing said speech rendering of the text email message comprises:

      accessing a Unified Messaging server and

      retrieving said text email message.

3. The method of claim 1 wherein said original message contains at least one attached document.

4. The method of claim 1 wherein said original message is a voice message and the step of providing said voice message comprises:

      accessing a Unified Messaging server and

      retrieving said voice message.

5. The method according to claim 2 wherein said step of providing a speech rendering of said original message comprises converting said text message to speech.

6. The method according to claim 3 wherein said step of providing a speech rendering of said original message comprises converting said attachment to speech.

7. The method according to claim 1 further comprising the step of connecting to the mailbox of said email message by establishing a voice connection using a landline telephone or a mobile telephone.

8. The method of claim 1 wherein said annotating step includes recognition of predefined commands for starting and stopping said speech annotation.

9. The method of claim 8 wherein said commands are speech commands.

10. The method of claim 8 wherein said commands are entered via Dual Tone Multi-Frequency (DTMF) tones.

11. The method of claim 8 further comprising the step of using an interactive voice response (IVR).

12. The method according to claim 8 wherein said speech commands are user defined.

13. The method of claim 1 further comprising the step of recognizing said speech annotations of said caller.

14. The method according to claim 1 further comprising the step of converting said speech annotations to text.

15. The method of claim 14 wherein said step of converting annotated voice command to text is accomplished using Automatic Speech Recognition (ASR) and Speech-to-Text conversion.

16. The method of claim 1 wherein said speech annotation is inserted in said original message in text format.

17. The method of claim 1 wherein said speech annotation is inserted in said original message as a sound file.

18. The method of claim 1 further comprising the step of storing said annotated message at a Unified Messaging server after inserting said speech annotation into said message.

19. The method according to claim 18 wherein said step of storing said annotated message includes creating a new copy of said message, said new copy including said original message and inserted annotations.

20. The method according to claim 1 further comprising the step of forwarding said annotated message to another user.

21. An apparatus for inserting a caller's speech annotations into an original message, comprising:
      means for providing speech rendering of said original message;
      means for annotating said speech message with at least one speech annotation; and
      means for inserting said speech annotation into said original message.

22. The apparatus of claim 21 wherein said original message is a text email message and the means for providing said speech rendering of the text email message comprises a Unified Messaging server.

23. The apparatus of claim 21 wherein said original message contains at least one attached document.

24. The apparatus of claim 21 wherein said original message is a voice message and the means for providing said text email message comprises a Unified Messaging server.

25. The apparatus according to claim 22 wherein said means of providing a speech rendering of said original message comprises means for converting said text message to speech.

26. The apparatus according to claim 23 wherein said means of providing a speech rendering of said original message comprises means for converting said attachment to speech.

27. The apparatus according to claim 21 further comprising means for connecting to the mailbox of said email message by establishing a voice connection using a landline telephone or a mobile telephone.

28. The apparatus of claim 21 wherein said annotating means includes means for recognition of commands for starting and stopping said speech annotation.

29. The apparatus of claim 28 wherein said commands are speech commands.

30. The apparatus of claim 28 wherein said commands are entered via Dual Tone Multi-Frequency (DTMF) tones.

31. The apparatus of claim 28 further incorporating the interactive voice response (IVR).

32. The apparatus according to claim 28 wherein said speech commands are user defined.

33. The apparatus of claim 21 further comprising means for recognizing said speech annotations of said caller.

34. The apparatus according to claim 21 further comprising means for converting said speech annotations to text.

35. The apparatus of claim 34 wherein said means of converting annotated voice command to text is accomplished using Automatic Speech Recognition (ASR) and Speech-to-Text conversion.

36. The apparatus of claim 21 wherein said speech annotation is inserted in said original message in text format.

37. The apparatus of claim 21 wherein said speech annotation is inserted in said original message as a sound file.

38. The apparatus of claim 21 further comprising means for storing said annotated message at a Unified Messaging server after inserting said speech annotation into said message.

39. The apparatus according to claim 38 wherein said means of storing said annotated message includes means for creating a new copy of said message, said new copy including said original message and inserted annotations.

40. The apparatus according to claim 21 further comprising the means for forwarding said annotated message to another user.

41. The method according to claim 18 wherein said step of storing said annotated message comprises:

querying whether to store said annotated message as a new copy or over said original message; and

storing said stored message responsive to a response to the query.

42. The apparatus according to claim 38 wherein said means of storing said annotated message comprises:

means for querying whether to store said annotated message as a new copy or over said original message; and

means for storing said stored message responsive to a response to the query.

EVIDENCE APPENDIX

This section lists evidence submitted pursuant to 35 U.S.C. §§1.130, 1.131, or 1.132, or any other evidence entered by the Examiner and relied upon by Appellant in this appeal, and provides for each piece of evidence a brief statement setting forth where in the record that evidence was entered by the Examiner. Copies of each piece of evidence are provided as required by 35 U.S.C. §41.37(c)(ix).

Exhibit	EVIDENCE	BRIEF STATEMENT SETTING FORTH WHERE IN THE RECORD THE EVIDENCE WAS ENTERED BY THE EXAMINER
A	**Application Figure 2**	**Originally filed with the application on July 24, 2003**
B	**Application Figure 1**	**Originally filed with the application on July 24, 2003**
C	**Spielberg Figure 12**	**First cited in an Office Action dated February 5, 2008**
D		
E		
F		
G		
H		
I		

EXHIBIT A

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        ┌─────────────┐
        │    START    │
        └─────────────┘
               │
               ▼
┌──────────────────────────────┐
│  VOICE CALLER ACCESSES UNIFIED│ ─── 200
│  MESSAGING SYSTEM TO RETRIEVE │
│     A TEXT EMAIL MESSAGE      │
└──────────────────────────────┘
               │
               ▼
┌──────────────────────────────┐
│     TEXT MESSAGE IS READ TO   │ ─── 210
│       VOICE CALLER USING      │
│    TEXT-TO-SPEECH CONVERSION  │
└──────────────────────────────┘
               │
               ▼
┌──────────────────────────────┐
│   CALLER INTERRUPTS MESSAGE   │ ─── 220
│  DELIVERY IN ORDER TO ANNOTATE│
│     THE DELIVERED MESSAGE     │
└──────────────────────────────┘
               │
               ▼
┌──────────────────────────────┐
│     CALLER SPEAKS THE DESIRED │ ─── 230
│          ANNOTATION           │
└──────────────────────────────┘
               │
               ▼
┌──────────────────────────────┐
│   SPEECH RECOGNITION SERVER   │ ─── 240
│   DETECTS THE VOICE ANNOTATION│
└──────────────────────────────┘
               │
               ▼
┌──────────────────────────────┐
│ SPEECH ANNOTATION IS CONVERTED│ ─── 250
│  TO TEXT OR SAVED AS A SOUND FILE│
└──────────────────────────────┘
               │
               ▼
┌──────────────────────────────┐
│   ANNOTATION IS APPENDED TO THE│ ─── 260
│      RENDERED MESSAGE AT      │
│   THE UNIFIED MESSAGING SERVER│
└──────────────────────────────┘
               │
               ▼
┌──────────────────────────────┐
│  MESSAGE DELIVERY IS RESUMED  │ ─── 270
└──────────────────────────────┘
               │
               ▼
        ┌─────────────┐
        │     END     │
        └─────────────┘
```
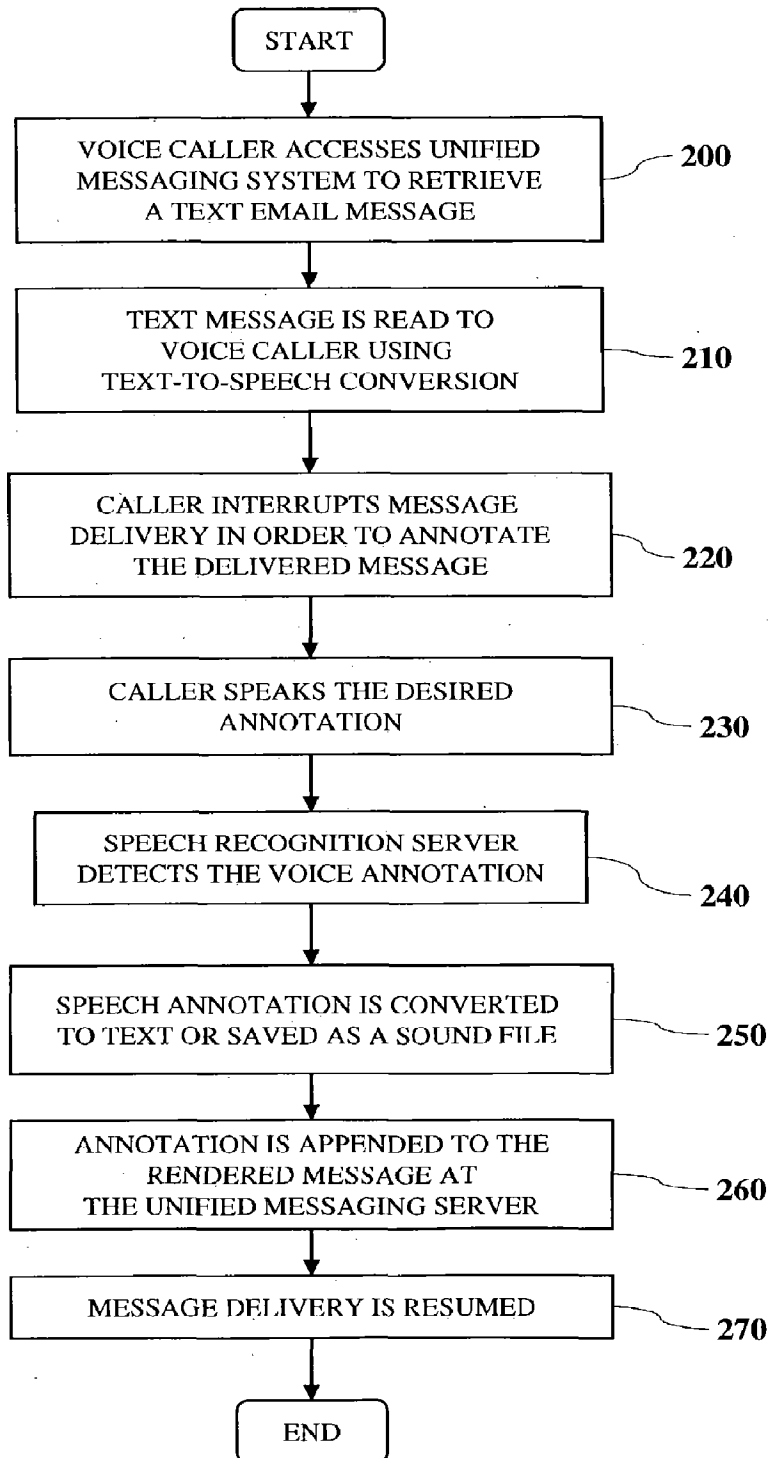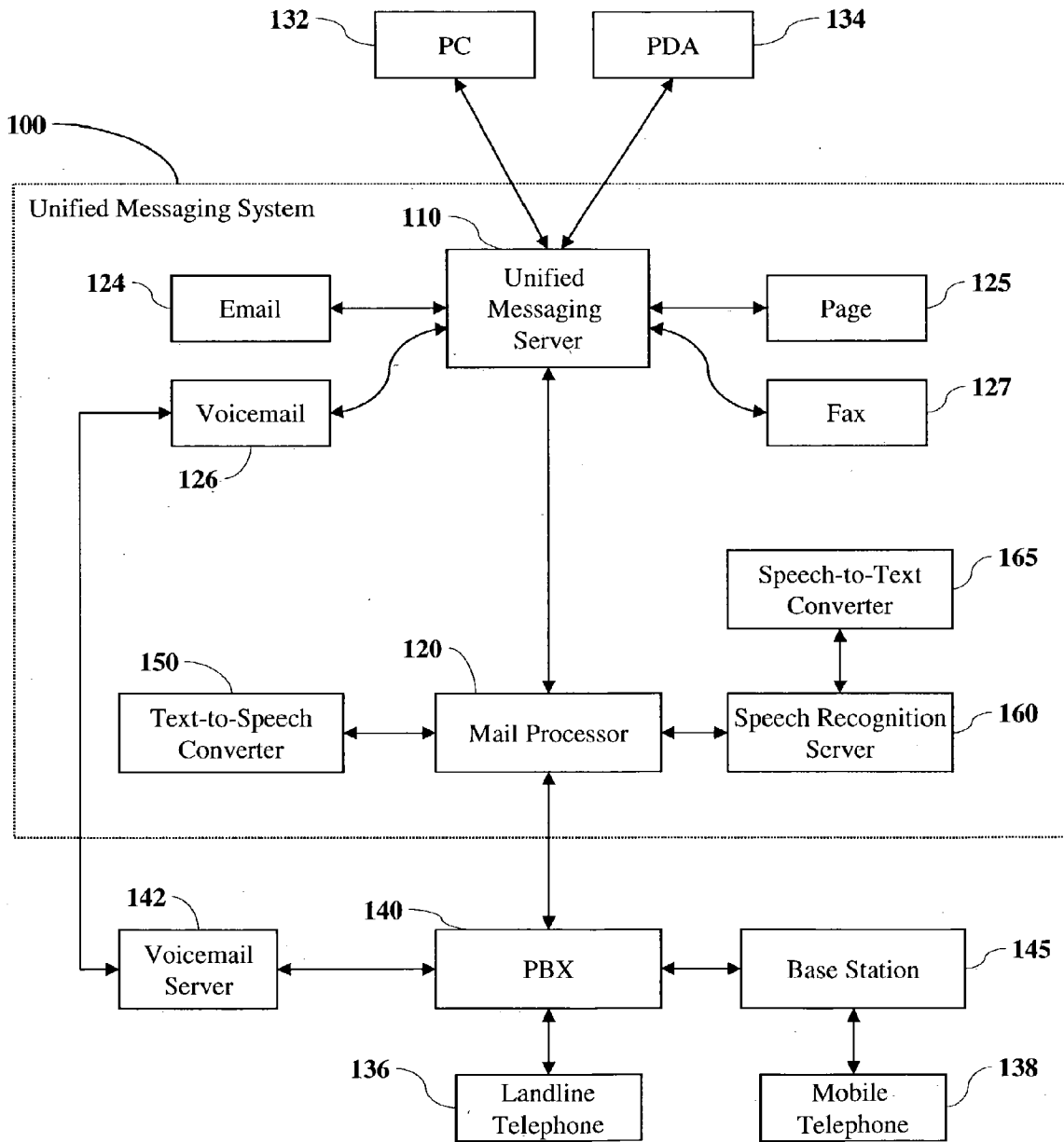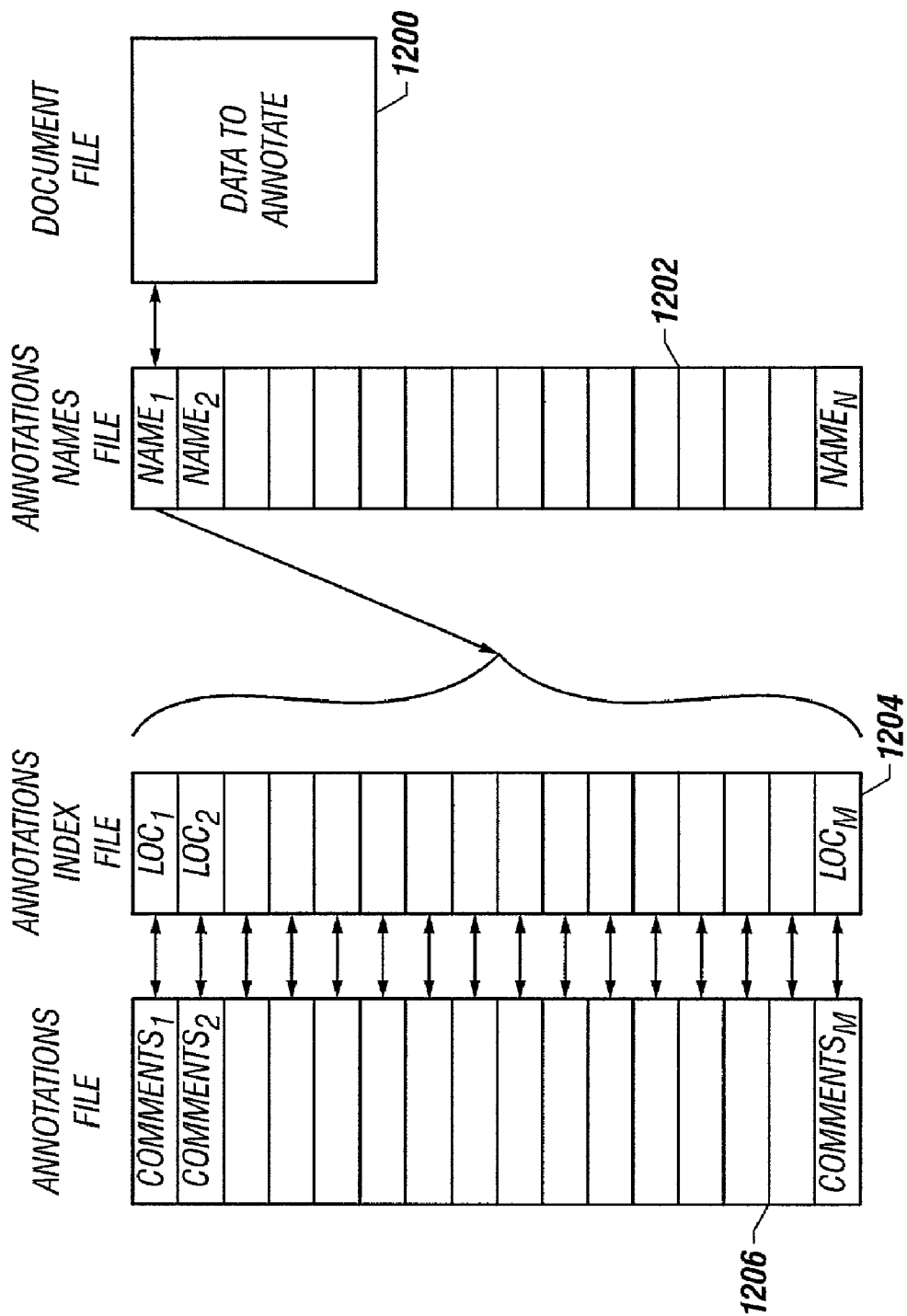
EXHIBIT B

EXHIBIT C

FIGURE 12

RELATED PROCEEDINGS APPENDIX

Pursuant to 35 U.S.C. §41.37(c)(x), copies of the following decisions rendered by a court of the Board in any proceeding identified above under 35 U.S.C. §41.37(c)(1)(ii) are enclosed herewith. As appellants are aware no decisions or proceedings having a bearing on the present appeal, nothing is included in the Appendix.